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Filing Date	07/06/2000
First Named Inventor	Patrick H. Hayes
Art Unit	2674
Examiner Name	Lesperance, Jean E.
Attorney Docket Number	81230.55US1

ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Customer No. 34018 - Greenberg Traurig, LLP		
Signature			
Printed name	Gary R. Jarosik		
Date	September 21, 2005	Reg. No.	35,906

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hayes et al.)	Examiner:	Lesperance, J.
)		
Serial No.:	09/611,620)	Art Unit:	2674
)		
Filed:	July 6, 2000)	Attny Doc.:	81230.55US1
)		
Title:	Consumer Electronic)		
	Navigation System And)		
	Methods Related Thereto)		

APPEAL BRIEF

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Dear Sir:

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's rejection of claims 49-75 which rejection was set forth in the Office Action mailed August 9, 2005. The pending claims have been rejected at least two times. A timely Notice of Appeal was filed.

This Appeal Brief is being filed in triplicate.

The required fee is submitted herewith.

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By: Ranni Matar
Ranni Matar

I. Real Party In Interest

The real party in interest is Universal Electronics Inc.

II. Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application, claims 49-75 remain pending and, having been rejected at least two times, are the subject of this appeal. Claims 1-48 have been previously cancelled. The attached Appendix provides a clean, double spaced copy of pending claims 49-75.

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of Claimed Subject Matter

The claimed invention is directed to a remote control (21) that monitors user input of navigation keys (22) *as part of a process which includes the navigation keys being activated to* transmit navigation commands to an appliance (e.g., commands to navigate a menu of a digital media such as a DVD playable on the appliance), that stores this keystroke data *while* the transmission of navigation commands occurs, and which allows the stored keystroke data to be repeated to thereby *repeat the transmission of the navigation commands to the appliance*. (See, for example, page 14, line 24-page 15, line 12; page 16, line 20-page 17, line 19; Figs. 3-6). The claimed invention further allows for the removal of activations on non-navigation keys, i.e., non-navigation commands,

from the stored sequence as well as the storing and repeating of the time between activations of navigation keys. (See, for example, page 14, line 24-page 15, line 8; page 18, lines 15-25; page 19, lines 1-18; Figs. 7-9). The claimed invention thus provides the user with the ability to repeat a sequence of transmitted navigation commands *after the fact*, i.e., *after the navigation commands have already been once transmitted to the appliance*. A saved key sequence of navigation commands is transparently saved by the remote control (21) *as the navigation commands are transmitted* by the user of the remote control (21) to the appliance in the first instance.

The claimed invention is also directed to a remote control that receives data from a digital media player. (See, for example, page 21, line 15-page 22, line 20). The data is used to define the navigation commands that are transmittable to the digital media player for controlling navigation within the menu system of the digital media player. Again, the claimed invention provides for storing a sequence of the navigation commands for subsequent transmission of those navigation commands to the digital media player.

As concerns the claimed “[storage] means for monitoring activations of the keys and for automatically storing a sequence of activations of the keys including the navigation keys during a process which also comprises the keys being activated to transmit to the consumer electronic device command codes to navigate the menu [system or of the digital media],” the structure which corresponds to the element claimed is described at, for example, page 13, lines 13+ with reference to Figures 3-5.

As concerns the claimed “means for repeating the stored sequence of activations of the keys [or for executing at least a subset of the sequence of activations of the keys] to thereby cause a retransmission to the consumer electronic device of command codes

corresponding to those activations of the keys that are within the stored sequence [or within the subset],” the structure which corresponds to the element claimed is described at, for example, page 16, lines 20+ with reference to Figures 3, 6, and 9.

As concerns the claimed “means for removing activations of non-navigation keys from the stored sequence,” the structure which corresponds to the element claimed is described at, for example, page 14, lines 14+ with reference to Figures 3-5.

As concerns the claimed “means for storing a time that elapses between activations of two keys within the sequence,” the structure which corresponds to the element claimed is described at, for example, page 18, lines 15+ with reference to Figures 7 and 8.

VI. Grounds Of Rejection To Be Reviewed On Appeal

A) Whether the acknowledgement by the examiner that Croy fails to include the disclosure required to maintain the rejection of claims 49-72 requires the withdrawal of the rejection.

B) Whether the rejection of claims 49-72 must be withdrawn since Croy fails to disclose the claimed invention “as a whole.”

C) Whether the rejection of claims 50, 53, and 63 must be withdrawn since Croy fails to disclose the claimed invention “as a whole.”

D) Whether the rejection of claims 51, 54, and 64 must be withdrawn since the combination of Croy and Abecassis fails to disclose the claimed invention “as a whole.”

E) Whether the rejection of claims 73-75 must be withdrawn since Croy fails to disclose the claimed invention “as a whole.”

VIII. Argument

The current status of the claims is as follows:

Claims 49, 50, 52, 53, 55-63, 65-67, and 70-75 stand rejected under 35 U.S.C. § 102 as being anticipated by Croy (U.S. Patent No. 6,040,829).

Claims 51, 54, 64, 68, and 69 stand rejected under 35 U.S.C § 103 as being rendered obvious by the combination of Croy and Abecassis (U.S. Patent No 6,289,165).

A) The Examiner Has Acknowledged That Croy Fails To Include The Disclosure Required To Maintain The Rejection Of Claims 49-72 Requiring The Withdrawal Of The Rejection

In the Office Action of August 9, 2005, on page 18 thereof, the Examiner has apparently acknowledged that the submenu system of Croy being relied upon in the rejection of the claims fails to disclose the claimed monitoring of key activations and storing of key activations during a process which also comprises the keys being activated to transmit [to a consumer electronic device] command codes to navigate the menu of a digital media [playable on the consumer electronic device]. In this regard, the Examiner has apparently ignored this claim element when making the determinations of anticipation/obviousness for the alleged reason that this claim element “is considered new matter” and “there is not enablement of the underlying part in the specification.” That this claim element is, however, supported and enabled by the specification as originally filed and must be considered when determining the patentability of the claims is evidenced not only by Figures 3-5 and the related description within the specification as originally filed (*see* Section V of this Brief) but also by the fact that the Examiner withdrew the rejection of the claims under 35 U.S.C. § 112 set forth in the Office Action

of August 13, 2005. (*see* page 2, paragraph 2 of the Office Action of August 9, 2005).

Thus, for the simple reason that the Examiner has apparently acknowledged that the disclosure within Croy is insufficient to support the conclusions of anticipation and obviousness the rejection of claims 49-72 must be withdrawn.

B) The Rejection Of Claims 49-72 Must Be Withdrawn Since Croy Fails To Disclose The Claimed Invention “As A Whole.”

It is well settled that an anticipation rejection or an obviousness rejection can be maintained only when a single reference or combination of references, respectively, disclose the invention claimed “as a whole,” i.e., each and every element considering each and every word.

Since Croy simply fails to disclose each and every element considering each and every word of independent claims 49, 52, and 57 the anticipation rejection of claims 49, 50, 52, 53, 55-63, 65-67, and 70-72 as well as the obviousness rejection of claims 51, 54, 64, 68, and 69 must be withdrawn.

Considering Croy, Croy describes a system that accepts explicit user input to initiate a special programming mode (e.g., selecting the “save” function from a menu as illustrated in Fig. 38) whereupon the user may enter a sequence of user interactions to program a menu that is locally displayed on the Croy personal navigator itself. (Col. 18, line 49 – Col. 19, line 1 and Figs. 39, 40 and 41). Croy does not mention nor does Croy infer that commands are transmitted from the personal navigator to a controlled device (let alone to navigate media playable on the controlled device) while the user is interacting with the locally displayed menu in this special programming mode. Thus,

nothing about the special programming mode of Croy can be said to disclose, teach, or suggest storing a sequence of key activations as part of a process which also comprises the keys being activated to transmit to a consumer electronic device command codes for commanding the consumer electronic device to navigate a digital medium playable on the consumer electronic device as is set forth in the claims under consideration.

Once the sequence entered by the user in the Croy programming mode is complete, the user assigns a name to the sequence (Col. 19, lines 2-7 and Fig. 42) whereby that sequence can be recalled by selecting a “recall” function and the name of the sequence to be executed (Col. 19, lines 11-16). Upon execution of a “recalled” sequence, the personal navigator causes a program listing to be displayed locally on the personal navigator (as illustrated in Fig. 46) in accordance with the sequence that was programmed by the user in the special programming mode. Croy does not mention nor does Croy infer that operation of the “recall” functions causes any sort of transmission (let alone a retransmission) to a consumer appliance of command codes as is set forth in the claims under consideration.

Thus, for the reason that Croy simply fails to disclose, teach, or suggest the claimed monitoring of activations of keys of a remote control and automatically storing a sequence of activations of the keys including navigation keys as part of a process that also comprises the keys being activated to transmit command codes to a consumer appliance to navigate a menu of a digital media playable on the consumer appliance or the retransmission of command codes corresponding to a sequence so stored (and it not being alleged that such is disclosed within Abecassis), it is respectfully submitted that claims 49-72 must be deemed allowable.

C) The Rejection Of Claims 50, 53, And 63 Must Be Withdrawn Since Croy Fails To Disclose The Claimed Invention “As A Whole.”

With regard to claims 53 and 63, the Appellant once again asserts that the disclosure by Croy of a “delete” key that “allows removal of the marked program from the list” cannot be said to disclose, teach, or suggest the claimed “removing activations of non-navigation keys from the stored sequence” as is set forth in claims 50, 53, and 63. In this regard, the Appellant has repeatedly questioned how a “marked program” *in a locally displayed menu* can be said to correspond to a “non-navigation key” which is activated as part of a sequence *used to transmit command codes* to a consumer electronic device for the purpose of navigating a digital media on that consumer electronic device. It is additionally questioned how removing a reminder of the imminent broadcast of marked program or programs can be said to have any relevance to removing activations of “non-navigation keys” from a sequence of key activations used to transmit commands to a consumer appliance as was alleged in the Office Action of August 9, 2005. Since Croy simply cannot be said to disclose at least the elements of claims 50, 53, and 63 it is submitted that these claims must be deemed to be allowable.

D) The Rejection Of Claims 51, 54, And 64 Must Be Withdrawn Since The Combination of Croy And Abecassis Fails To Disclose The Claimed Invention “As A Whole.”

It has been acknowledged that Croy fails to disclose the elements of claims 51, 54, and 64. As concerns Abecassis, the Appellant has continually questioned how the voice response subsystem of Abecassis which accommodates commands such as play,

stop, and pause can be said to correspond to the claimed [means for] storing the time between actuations of two keys in a sequence of key activations. More specifically, the Appellant has submitted that a voice response subsystem functions, by definition, to use voice input for the purpose of *eliminating* the activating of keys. Therefore, times between key activations could never even arise in the system of Abecassis (for the simple reason that keys are never interacted with) and, as such, there can be no possible reading of Abecassis that can be said to suggest the storing of that which the system of Abecassis renders non-existent. Furthermore, the mere fact that there may exist interkey pause times when commands such as play, stop, and pause are activated one after another as suggested in the Office Action of August 9, 2005 simply cannot be said to suggest the desirability of *storing* such interkey pause times. Yet further, the motivation put forth in the Office Action of August 9, 2005 for modifying Croy (“that it would be obvious to utilize the pause key as taught by Abecassis in the remote device disclosed by Croy because this would provide a video’s foreground and background elements to provide audio during a video pause”) cannot stand up to close scrutiny as it is totally irrelevant to the subject matter and purpose of the invention set forth in the claims. Therefore, for the simple reason that Abecassis cannot be said to disclose at least the elements of claims 51, 54, and 64 and, therefore, cannot be said to suggest modifying Croy to include the same, it is submitted that these claims must be deemed allowable.

E) The Rejection Of Claims 73-75 Must Be Withdrawn Since Croy Fails To Disclose The Claimed Invention “As A Whole.”

With respect to the rejection of claims 73-75, it is respectfully submitted that this rejection must be withdrawn since Croy fails to disclose the claimed “programming...for receiving data from the player used to define navigation commands that are transmittable to the player for controlling navigation within the menu system [of the media player] and for storing a sequence of the navigation command for subsequent transmission to the player.” While Croy may disclose at Col. 4, lines 15-19 that “the transmission of data can be one-way or two way” and may disclose at Col. 10, lines 53-63 that a *locally displayed menu* is navigable in response to activation of a key, it is respectfully noted that the cited passages never expressly or inferentially describe receiving data *from the player used to define navigation commands that are transmittable to the player for controlling navigation within the menu system* of the player and for storing a sequence of the navigation commands for subsequent transmission to the player as is claimed. Therefore, since Croy fails to disclose, teach, or suggest at least these claimed elements, claims 73-75 must be deemed to be allowable.

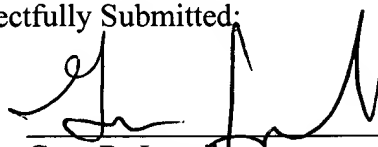
F) Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Date: September 21, 2005

Respectfully Submitted:

By:

A handwritten signature in black ink, appearing to read 'Gary R. Jarosik', written over a horizontal line.

Gary R. Jarosik
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VIII. Claims Appendix

The following is a clean copy of the pending claims:

49. A remote control operable with a consumer electronic device, the remote control comprising:

a plurality of keys including navigation keys that are activatable to transmit to the consumer electronic device command codes for commanding the consumer electronic device to navigate a menu of a digital media playable on the consumer electronic device;

storage means for monitoring activations of the keys and for automatically storing a sequence of activations of the keys including the navigation keys during a process which also comprises the keys being activated to transmit to the consumer electronic device command codes to navigate the menu of the digital media; and

means for repeating the stored sequence of activations of the keys to thereby cause a retransmission to the consumer electronic device of command codes corresponding to those activations of the keys that are within the stored sequence.

50. The remote control of claim 49, comprising means for removing activations of non-navigation keys from the stored sequence.

51. The remote control of claim 49, wherein the storage means comprises means for storing a time that elapses between activations of two keys within the sequence.

52. A remote control operable with a consumer electronic system having a consumer electronic device and a removable digital medium operable with the consumer electronic device, the medium including a menu system, the remote control comprising:

a plurality of keys including navigation keys that are activatable to transmit to the consumer electronic device command codes for commanding the consumer electronic device to navigate the menu system;

a transmitter providing communication with the consumer electronic device in response to activation of at least one of the keys;

means for monitoring activations of the keys and for automatically storing a sequence of activations of the keys including the navigation keys during a process which also comprises the keys being activated to transmit to the consumer electronic device command codes to navigate the menu system; and

means for executing at least a subset of the sequence of activations of the keys to thereby cause a retransmission to the consumer electronic device of command codes corresponding to those activations of the keys that are within the subset.

53. The remote control of claim 52, comprising means for removing activations of non-navigation keys from the stored sequence to create the subset of the sequence.

54. The remote control of claim 52, wherein the means for storing the sequence comprises means for storing a time that elapses between activations of two keys within the sequence.

55. The remote control of claim 52, wherein the means for executing a subset of the sequence is responsive to activation of a single key.

56. The remote control of claim 55, wherein the single key is predetermined.

57. In a remote control having a plurality of keys including navigation keys, a readable medium having instructions for navigating secondary material provided on a removeable digital medium playable on a consumer electronic device, the instructions performing steps comprising:

monitoring user activations of the keys for sensing a sequence of user activations of the keys including the navigation keys when used to transmit to the consumer electronic device command codes for commanding the consumer electronic device to navigate the secondary material of the digital medium;

automatically storing the sequence as part of a process which also comprises the keys being activated to transmit to the consumer electronic device command codes for commanding the consumer electronic device to navigate the secondary material of the digital medium; and

allowing a user to execute at least a subset of the stored sequence of activations of the keys to thereby cause a retransmission to the consumer electronic device of command codes corresponding to those activations of the keys that are within the subset to command the consumer electronic device to navigate the secondary material of the digital medium.

58. The readable medium of claim 57, wherein the user activations of the keys commands the consumer electronic device to navigate the secondary material to a desired screen and executing the stored sequence commands the consumer electronic device to again navigate to the desired screen.

59. The readable medium of claim 58, wherein executing the stored sequence commands the consumer electronic device to display each screen that was displayed when the sequence of user activations was sensed.

60. The readable medium of claim 58, wherein executing the stored sequence commands the consumer electronic device to display the last screen that was displayed when the sequence of user activations was sensed.

61. The readable medium of claim 57, wherein the instructions further provide for commanding the consumer electronic device to display primary material provided on the removable medium.

62. The readable medium of claim 57, wherein the instructions further provide for controlling operation of the consumer electronic device.

63. The readable medium of claim 57, wherein the instructions further perform the step of removing the activation of non-navigation keys from the sequence to create the subset.

64. The readable medium of claim 57, wherein the instructions further perform the step of storing a time that elapses between activations of two keys within the sequence.

65. The readable medium of claim 57, wherein the instructions further perform the step of identifying the start and end points of the sequence.

66. The readable medium of claim 57, wherein activation of a single key allows a user to execute the stored sequence.

67. The readable medium of claim 57, wherein the instructions further perform the step of preventing memory overflow.

68. The readable medium of claim 57, wherein the remote control is operable with a digital video disc player and the instructions further perform the step of determining if the remote control is in a DVD mode.

69. The readable medium of claim 68, wherein the instructions further perform the step of placing the remote control in the DVD mode when executing the stored sequence.

70. The readable medium of claim 69, wherein activation of a single key allows a user to execute the stored sequence.

71. The readable medium of claim 57, wherein storing the sequence occurs in response to activating a predetermined key.

72. The readable medium of claim 71, wherein activation of the predetermined key also allows a user to execute the stored sequence.

73. A remote control adapted for use with a media player using a menu system, the remote control comprising:

a bi-directional communication system;

a processor connected to the communication system; and

programming operable with the processor and the bi-directional communication system for receiving data from the player used to define navigation commands that are transmittable to the player for controlling navigation within the menu system and for storing a sequence of the navigation commands for subsequent transmission to the player.

74. The remote control of claim 73, wherein the programming is adapted to process preprogrammed sequences of data transmitted by the player.

75. The remote control of claim 73, wherein the programming is adapted to define a plurality of keys based upon the data received from the player.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No decisions in any related proceedings or applications are submitted herewith.